



Marketing origin-based foodstuffs: lessons from the rooibos and Karoo lamb industries

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The WTO Trade Related Intellectual Property Rights (TRIPS) Agreement recognises Geographical Indications (GIs) as a distinct category of intellectual property (IP) rights. The Agreement defines GIs as “indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.” GIs are therefore origin-based product names that signal a link between a product, its origin and some unique product quality or reputation. Famous GIs include products such as Champagne, Parma ham and Roquefort cheese. These products have, over time, developed a strong reputation for the specific qualities attached to the region from which they originate. While European countries have a long-standing tradition of legally protecting origin-based product names, the more recent international recognition of GI has introduced the legal obligation to do so in all WTO Member countries. Growing awareness of the need to protect the reputation embedded in origin-based names have gone hand in hand with a growing consumer awareness of and demand for products with an identifiable origin given concerns

over food safety but also a renewed awareness of heritage and a need to associate with the values embedded in local products. These consumer trends have resulted in significant marketing value being captured in origin-based product names. With the potential to derive profits from the use of names attached to a territory, instances of misappropriation have been on the rise. In a globalised marketplace, both the value of and the potential for misappropriation is increased.

The South African rooibos industry first recognised the extent of this threat when in the early 1990s it was faced with a US trade mark registration for the name rooibos which effectively barred the industry from using the word rooibos to describe its product in the United States. Following a lengthy and costly legal battle, the industry succeeded in expunging the trade mark on the grounds that the term rooibos is descriptive of a type of product and therefore generic. This experience served as a costly warning to the South African rooibos industry which then decided to devise an IP strategy for protecting its rights to the name rooibos on international markets.

In the absence of an international registration system¹ and with the EU being the major export market

for rooibos, the industry decided to pursue protection under EU Regulation 510/2006. This regulation creates a registration system which operates independently of the EU Community trade mark register and which provides a mechanism for registering and protecting origin-based product names in all EU Member States. Producer groups that want to apply for protection under EU Regulation 510/2006 need to draft a product specification in which the region of production is demarcated and the production practises which give rise to the product’s unique qualities attached to the region are elaborated.

With the assistance of researchers at the University of Pretoria and the Western Cape Department of Agriculture, the rooibos industry embarked on drafting this specification, a process which lasted nearly five years. Protection under EU Regulation 510/2006 is, however, as in the case of GI protection under the WTO TRIPS agreement, made dependent on the GI being protected in its country of origin. In order to qualify for protection, the rooibos industry thus first had to ensure protection domestically.

As countries are merely required to provide the “legal means” through which to protect GIs according to

¹ The creation of a multilateral register for GIs is being debated as part of the WTO TRIPS agreement ongoing negotiations. See Bramley and Bienabe, 2012. *Developments and considerations around geographical indications in the developing world*. Queen Mary Journal of Intellectual Property, (21).

the minimum standards under TRIPS, it is left to countries to decide on the legal mechanism to provide the required protection domestically. While a variety of legal means can be used to ensure TRIPS compliance, countries primarily comply with their TRIPS obligations by either providing a unique registration system such as that under EU Regulation 510/2006 or by protecting GIs under existing trade mark laws. The South African government opted to provide protection for GIs under the Trade Marks Act 194 of 1993. Industries seeking to protect their GIs can do so in South Africa by either registering a certification mark or a collective mark. Once registered under the Trade Marks Act, the GI is protected in South Africa against confusing or misleading use in relation to the goods and/or services for which it is registered.

In order to comply with the requirement of domestic protection, the rooibos industry applied for registration of a certification mark. However at the end of 2012, before submitting the EU GI application, the industry was made aware of a series of trade mark applications brought by a French company and which sought to secure rights to the name rooibos in France. As the industry had not yet filed its GI application under EU Regulation 510/2006, it had no established rights under French or EU law to oppose the applications. While the industry notified the Industrial Property Office in France of its interest in the name rooibos, the risk remains that these applications will proceed to registration, again confronting the industry with the loss of the right to use its name.

Recognising the growing threat of misappropriation on both domestic and international markets, the Karoo Development Foundation recently registered the certification mark Karoo Meat of Origin in South Africa.



Figure 1:
The Karoo Meat of Origin certification mark
The Karoo Meat of Origin Scheme seeks to ensure the integrity of Karoo Meat by certifying that meat bearing the Karoo Meat of Origin mark originates from the Karoo and that it meets the standards of production set out in

the codes of practice. Producers, abattoirs, restaurants and other outlets interested in using the mark may apply for certification. The South African Meat Industry Corporation (SAMIC) has been appointed to inspect and audit use of the mark. Since inception of the Scheme in 2012, 99 entities have been certified to use the mark. The Karoo Meat of Origin Scheme has also been registered as an approved protocol with the Department of Agriculture, Forestry and Fisheries (DAFF). Resulting from a peculiar interplay with Regulation 47 of R146 under the Foodstuffs, Cosmetics and Disinfectants Act 54 of 1972, which prohibits use of the name Karoo lamb unless it is done in terms of an approved protocol or regulation, it is now effectively unlawful to use the name Karoo lamb unless the use thereof has been certified under the Karoo Meat of Origin Scheme.

The experience of these two South African origin-based industries emphasises the importance of protecting the IP which vests in origin-based terms both domestically and on international markets. This protection can be secured by filing a GI application in those countries where a dedicated legal system for GIs exist, or through utilising the existing trade mark system to the extent that it provides protection for origin-based terms. Either way, it is crucial for industries to be proactive instead of reactive in devising appropriate IP strategies for the protection of origin-based terms used in the marketing of foodstuffs.



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